

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Volker WENDEL et al.

Group Art Unit: 1616

Appln. No. : 10/789,753

Examiner: DODSON

Filed : February 27, 2004

Confirmation No.: 9581

For : COSMETIC AND DERMATOLOGICAL LIGHT-PROTECTIVE
FORMULATIONS WITH A CONTENT OF PARTICULATE UV-FILTER
SUBSTANCES AND ALKYLNAPHTHALATES

SUBMISSION OF TERMINAL DISCLAIMER

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Further to the Amendment Under 37 C.F.R. 1.111, filed October 26, 2006, and following a November 9, 2006 telephone conversation with the Examiner, Applicants are submitting herewith an executed Terminal Disclaimer to advance prosecution of the application to allowance.

In particular, during the above-noted telephone conversation with Applicants' representative Arnold Turk, the Examiner indicated that upon review of the application it appears that the application would be placed into condition for allowance by submission of an executed Terminal Disclaimer disclaiming the applications cited in the double patenting rejections. The Examiner indicated that she would await the filing of a Terminal Disclaimer prior to issuance of a Final Office Action if a Terminal Disclaimer could be filed shortly.

Applicants express appreciation for the thorough examination of the application by the Examiner as well as the Examiner's telephone call to Applicants' representative to advance prosecution of the application.

As noted above, Applicants submit herewith an executed Terminal Disclaimer to advance prosecution of the application to allowance. This Terminal Disclaimer is being presented without expressing agreement or acquiescence with the rejection of record, and is merely being filed to place the application into consideration for allowance.

Authorization is hereby provided to charge any fee necessary for consideration or entry of this paper and/or the Terminal Disclaimer to Deposit Account No. 19-0089.

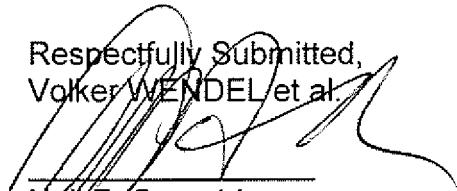
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
Volker WENDEL et al.


Neil F. Greenblum
Reg. No. 28,394

November 27, 2006
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P30594.A04

Appln. No. 10/789,753

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TERMINAL DISCLAIMER

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Alexandria, VA 22314

Sir:

Your petitioner, BEIERSDORF AG, a corporation organized and existing under the laws of Germany, whose business address is Unnastrasse 48, D-20245 Hamburg, GERMANY, represents that it is the owner of record of the entire right, title and interest of the above-identified application by virtue of an assignment recorded in the U.S. Patent and Trademark Office on August 19, 2004 at Reel 015073, Frame 0445 of U.S. Application No. 10/789,753 for "Cosmetic And Dermatological Light-Protective Formulations With A Content Of Particulate UV-Filter Substance And Alkylnaphthalates" and of U.S. Patent Application No. 10/500,869, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on October 8, 2004 at Reel 015872, Frame 0745, U.S. Patent Application No. 10/789,881, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on August 9, 2004 at Reel 015057, Frame 0557, U.S. Patent Application No. 10/789,641, by virtue of an assignment recorded in the U.S.

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Patent and Trademark Office on August 20, 2004 at Reel 015076, Frame 0526, U.S. Patent Application No. 10/789,750, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on August 9, 2004 at Reel 015060, Frame 0628, and U.S. Patent Application No. 10/788,607, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on August 9, 2004 at Reel 015057, Frame 0541, U.S. Patent Application No. 10/789,751, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on August 3, 2004 at Reel 015043, Frame 0492, and U.S. Patent Application No. 10/789,711, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on March 28, 2005 at Reel 015964, Frame 0135.

The undersigned representative is authorized to act on behalf of the assignee, and it is certified that to the best of the undersigned's knowledge and belief, title is in the assignee.

Your petitioner, BEIERSDORF AG, hereby disclaims, except as provided below, the terminal part of any patent granted on the above-identified application which would extend beyond the expiration date of any patent granted on U.S. Application Nos. 10/500,869, 10/789,881, 10/789,641, 10/789,750, 10/788,607, 10/789,751, and 10/789,711, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to any patent granted on United States Application Nos. 10/500,869, 10/789,881, 10/789,641, 10/789,750, 10/788,607, 10/789,751, and 10/789,711, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

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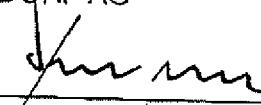
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Petitioner does not disclaim any terminal part of any patent granted on the above identified application prior to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 as presently shortened by any terminal disclaimer of any patent granted on Application Nos. 10/500,869, 10/789,881, 10/789,641, 10/789,750, 10/788,607, 10/789,751, and 10/789711 in the event that any patent granted on these applications later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the failure of common ownership stated above.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,
BEIERSDORF AG

By


Name: H.-H. Bernhardt

Vice President General Counsel
Title and Taxation

November 23, 2006